

PATENT
Attorney Docket No. 20008/G012B-US

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

PETITION UNDER 37 C.F.R. §1.47(a)

Mail Stop Missing Parts
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This petition under the provisions of 37 C.F.R. §1.47(a) is submitted in response to the Notification of Missing Requirements under 35 U.S.C. 371 In the United States Designated/Elected Office mailed on November 27, 2006, and accompanies a response to the same.

Transmitted with the accompanying Response to the Notification of Missing Requirements is a Declaration and Power of Attorney document executed by joint inventor Hongjun X. Ning for himself and on behalf of the non-signing co-inventor, Stephen J. Wilkins (“Wilkins”). It is asserted herein that in accordance with 37 C.F.R. §1.47(a), joint inventor Stephen J. Wilkins is uncooperative and refuses to sign the Declaration.

A Statement of Facts Under 37 C.F.R. §1.47(a), executed by the by the person who presented the non-signing co-inventor, Wilkins, with the application papers and to whom the refusal to sign the Declaration was made, is submitted in support of this petition. The Statement of Facts reveals that diligent efforts have been made to obtain co-inventor Wilkins'

signature on the Declaration and Power of Attorney document for the above-identified patent application.

The last known current address for the non-signing co-inventor Wilkins is:

17695 Dawn Court
Gurnee, IL 60031

A payment via electronic funds transfer in the amount of \$2,290.00 is included. The payment includes \$130.00 to cover the requisite fee established by 37 C.F.R. §1.17(h) for this paper and \$2,160.00 to cover a five-month extension of time for responding to the Notification of Missing Requirements.

On the basis of the facts presented in the attached Statement of Facts and for the foregoing reasons, it is respectfully requested that the Commissioner accept this petition as it is in accordance with the requirements of 37 C.F.R. §1.47(a). As patent counsel for the Assignee, the undersigned is hereby authorized to sign on behalf of the Assignee and is filing this petition on behalf of the Assignee to protect the Assignee's interest and avoid irreparable damage thereto. Consideration and examination of the application in due course is respectfully requested.

Should the Petitions Officer have any question of form or substance, the Officer is invited to contact the undersigned attorney at the telephone number and address listed below.

Respectfully submitted,

HANLEY, FLIGHT & ZIMMERMAN, LLC
USPTO Customer Number 34431
150 South Wacker Drive, Suite 2100
Chicago, Illinois 60606
(312) 580-1020

By: /Mark G. Hanley/
Mark G. Hanley
Registration No. 44,736
Attorney for Applicants

June 27, 2007

PATENT
Attorney Docket No. 20008/G012B-US

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

STATEMENT OF FACTS ACCOMPANYING PETITION UNDER 37 C.F.R. §1.47(a)

Mail Stop Missing Parts
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This Statement is made as to the facts that are relied upon to establish the diligent effort made to secure the execution of the Declaration by the non-signing co-inventor for the above-identified application. This Statement is made by the person having first-hand knowledge of the facts relied upon herein.

1. The non-signing co-inventor, Stephen J. Wilkins (“Wilkins”), was formerly employed by R.R. Donnelley & Sons Company (“R.R. Donnelley”), the Assignee in the above-referenced application.

2. While an employee of R.R. Donnelley, Wilkins jointly invented the subject matter of the above-referenced application.

3. On August 31, 2006, Felipe Hernandez (“Hernandez”), a law clerk at the law firm Hanley, Flight and Zimmerman, LLC, outside patent counsel for the Assignee, forwarded paper copies of the Declaration (*see* Exhibit A) and the patent application for the above-referenced application to Wilkins’ last known current address (17695 Dawn Court,

Gurnee, IL 60031) including a letter (*see* Exhibit B) requesting that Wilkins sign the Declaration. The paper copy of the patent application, the Declaration, the letter, and a postage paid envelope addressed to Hanley, Flight and Zimmerman, LLC (*see* Exhibit C) were sent via United Parcel Service (“UPS”), Next Day Air (*see* Exhibit D).

4. UPS confirmed that the package was delivered on September 1, 2006, at 10:33 AM. *See* Exhibit E.

5. On September 7, 2006, Wilkins telephoned Hernandez expressing his refusal to sign the Declaration.

This Statement of Facts under 37 C.F.R. § 1.47(a) is signed by Felipe Hernandez, the person who presented the non-signing co-inventor, Wilkins, with the application papers and to whom the refusal to sign the Declaration was made.

Respectfully submitted,

HANLEY, FLIGHT & ZIMMERMAN, LLC
USPTO Customer Number 34431
150 South Wacker Drive, Suite 2100
Chicago, Illinois 60606
(312) 580-1020

By: /Felipe Hernandez/
Felipe Hernandez
Law Clerk, Technical Specialist

June 27, 2007

EXHIBIT A

Atty. Docket No: 20008/G012B-US

DECLARATION FOR PATENT APPLICATION AND POWER OF ATTORNEY

As a below named inventor, I hereby declare that my residence, post office address and citizenship are as stated below next to my name; I believe that I am the original, first inventor of the subject matter which is claimed and for which a patent is sought on the invention entitled "**METHODS AND APPARATUS TO DELIVER INK TO PRINTING SYSTEMS**," which was assigned U.S. Serial No. 10/574,410 and filed on March 30, 2006. I hereby state that I have reviewed and understand the contents of the above-identified specification, including the claims, as amended by any amendment(s) referred to above. I acknowledge the duty to disclose to the Patent and Trademark Office all information known to me to be material to patentability as defined in 37 C.F.R. §1.56.

I hereby claim foreign priority benefits under 35 U.S.C. §119 of any foreign application(s) for patent or inventor's certificate or of any PCT international application(s) designating at least one country other than the United States of America listed below and have also identified below any foreign application(s) for patent or inventor's certificate or any PCT international application(s) designating at least one country other than the United States of America filed by me on the same subject matter having a filing date before that of the application(s) of which priority is claimed:

Priority Claimed

(Application Serial Number)	(Country)	(Day/Month/Year Filed)	<input type="checkbox"/> Yes	<input type="checkbox"/> No
(Application Serial Number)	(Country)	(Day/Month/Year Filed)	<input type="checkbox"/> Yes	<input type="checkbox"/> No

I hereby claim the benefit under 35 U.S.C. §119(e) of any United States provisional application(s) listed below:

Priority Claimed

60/508,571	US	10/03/2003	<input checked="" type="checkbox"/> Yes	<input type="checkbox"/> No
(Application Serial Number)	(Country)	(Day/Month/Year Filed)	<input type="checkbox"/> Yes	<input type="checkbox"/> No

I hereby claim the benefit under 35 U.S.C. §120 of any United States application(s) or PCT international application(s) designating the United States of America listed below and, insofar as the subject matter of each of the claims of this application is not disclosed in the prior application(s) in the manner provided by the first paragraph of 35 U.S.C. §112, I acknowledge the duty to disclose to the Office all information known to me to be material to patentability as defined in 37 C.F.R. §1.56 which occurred between the filing date of the prior application(s) and the national or PCT international filing date of this application:

PCT/US04/32413	10/01/2004	Pending
(Application Serial Number)	(Day/Month/Year Filed)	(Status-Patented, Pending or Abandoned)
(Application Serial Number)	(Day/Month/Year Filed)	(Status-Patented, Pending or Abandoned)

EXHIBIT A (Cont.)

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under 18 U.S.C. §1001 and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

POWER OF ATTORNEY: I hereby appoint **the Practitioners at Customer Number 34431** as my attorneys, with full powers of substitution and revocation, to prosecute this application and transact all business in the Patent and Trademark Office connected therewith.

Send correspondence and direct telephone calls to:

Hanley, Flight & Zimmerman, LLC at customer number **34431**
Phone (312) 580-1020
Fax (312) 580-9696

Full Name of First or Sole Inventor Hongjun X. Ning	Citizenship United States
Residence Address – Street #3-2 Yi Fei Garden, Royal Family, Ya Dong Xinchen, Xianlin District	Post Office Address – Street #3-2 Yi Fei Garden, Royal Family, Ya Dong Xinchen, Xianlin District
City (Zip) Nanjing City	City (Zip) Nanjing City
State or Country Jiangsu Province	State or Country P.R. China
Date <input checked="" type="checkbox"/>	Signature <input checked="" type="checkbox"/>

Second Joint Inventor, if any Stephen J. Wilkins	Citizenship United States
Residence Address – Street 17695 Dawn Court	Post Office Address - Street SAME
City (Zip) Gurnee (60031)	City (Zip) SAME
State or Country Illinois	State or Country United States
Date <input checked="" type="checkbox"/>	Signature <input checked="" type="checkbox"/>

EXHIBIT A (Cont.)

APPLICABLE RULES AND STATUTES

37 CFR 1.56. DUTY OF DISCLOSURE - INFORMATION MATERIAL TO PATENTABILITY (Applicable Portion)

(a) A patent by its very nature is affected with a public interest. The public interest is best served, and the most effective patent examination occurs when, at the time an application is being examined, the Office is aware of and evaluates the teachings of all information material to patentability. Each individual associated with the filing and prosecution of a patent application has a duty of candor and good faith in dealing with the Office, which includes a duty to disclose to the Office all information known to that individual to be material to patentability as defined in this section. The duty to disclose information exists with respect to each pending claim until the claim is canceled or withdrawn from consideration, or the application becomes abandoned. Information material to the patentability of a claim that is canceled or withdrawn from consideration need not be submitted if the information is not material to the patentability of any claim remaining under consideration in the application. There is no duty to submit information which is not material to the patentability of any existing claim. The duty to disclose all information known to be material to patentability is deemed to be satisfied if all information known to be material to patentability of any claim issued in a patent was cited by the Office or submitted to the Office in the manner prescribed by §§ 1.97(b)-(d) and 1.98. However, no patent will be granted on an application in connection with which fraud on the Office was practiced or attempted or the duty of disclosure was violated through bad faith or intentional misconduct. The Office encourages applicants to carefully examine:

- (1) prior art cited in search reports of a foreign patent office in a counterpart application, and
- (2) the closest information over which individuals associated with the filing or prosecution of a patent application believe any pending claim patentability defines, to make sure that any material information contained therein is disclosed to the Office.

Information relating to the following factual situations enumerated in 35 USC 102 and 103 may be considered material under 37 CFR 1.56(a).

35 U.S.C. 102. CONDITIONS FOR PATENTABILITY: NOVELTY AND LOSS OF RIGHT TO PATENT

A person shall be entitled to a patent unless --

- (a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for patent, or
- (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of the application for patent in the United States, or
- (c) he has abandoned the invention, or
- (d) the invention was first patented or caused to be patented, or was the subject of an inventor's certificate, by the applicant or his legal representatives or assigns in a foreign country prior to the date of the application for patent in this country on an application for patent or inventor's certificate filed more than twelve months before the filing of the application in the United States, or
- (e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraph (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent, or
- (f) he did not himself invent the subject matter sought to be patented, or
- (g) before the applicant's invention thereof the invention was made in this country by another who had not abandoned, suppressed, or concealed it. In determining priority of invention there shall be considered not only the respective dates of conception and reduction to practice of the invention, but also the reasonable diligence of one who was first to conceive and last to reduce to practice, from a time prior to conception by the other.

35 U.S.C. 103. CONDITIONS FOR PATENTABILITY; NON-OBVIOUS SUBJECT MATTER (Applicable Portion)

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Subject matter developed by another person, which qualifies as prior art only under subsection (f) or (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

35 U.S.C. 112. SPECIFICATION (Applicable Portion)

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same, and shall set forth the best mode contemplated by the inventor of carrying out his invention.

EXHIBIT B



20 N. Wacker Drive | Suite 4220

Chicago, IL 60606

(p) 312.580.1020 | (f) 312.580.9696

hfzlaw.com

August 31, 2006

Via Courier

Mr. Stephen J. Wilkins
17695 Dawn Court
Gurnee, Illinois 60031

Re: U.S. Patent Application Serial No. 10/574,410
International Application No. PCT/US04/32413
Applicant: R.R. Donnelley & Sons Company
Title: METHODS AND APPARATUS TO DELIVER INK TO
PRINTING SYSTEMS
Your Reference: G012B-US
Our Reference: 20008/G012B-US

Dear Mr. Wilkins,

We recently filed the above-referenced U.S. national stage patent application with the United States Patent and Trademark Office ("USPTO"). The U.S. national stage application is based on international application number PCT/US04/32413 filed in the Patent Cooperation Treaty ("PCT") on October 1, 2004.

Enclosed for your review are copies of the above-referenced application as filed on March 30, 2006. Also enclosed is a copy of the declaration document prepared for your signature. To complete the filing process, after reviewing the application, please review and sign the declaration and return it to our firm as soon as possible for filing with the USPTO. To assist you, enclosed is a postage paid, self-addressed envelope. We must file the executed declaration to avoid abandonment of the application. Accordingly, we kindly request return of the signed document as soon as possible.

Thank you in advance for your assistance in this matter. I look forward to receiving this document from you. In the meantime, if you have any questions or concerns related to these documents, please do not hesitate to contact me directly at (312) 580 1131.

Best regards,

A handwritten signature in black ink, appearing to read 'Felipe H' followed by a stylized surname.

Felipe Hernandez

FH/sd
Enclosures

EXHIBIT C**UPS Internet Shipping: View/Print Label**

1. Ensure that there are no other tracking labels attached to your package.
2. Fold the printed label at the dotted line. Place the label in a UPS Shipping Pouch. If you do not have a pouch, affix the folded label using clear plastic shipping tape over the entire label.

3. GETTING YOUR SHIPMENT TO UPS**Customers without a Daily Pickup**

- Schedule a same day or future day Pickup to have a UPS driver pickup all of your Internet Shipping packages.
- Hand the package to any UPS driver in your area.
- Take your package to a location of The UPS Store®, UPS Drop Box, UPS Customer Center or Authorized Shipping Outlet near you. Items sent via UPS Return Services (including Ground Returns) are accepted at any UPS Drop Box.
- To find the location nearest you, please visit the 'Find Locations' Quick link at ups.com.

Customers with a Daily Pickup

- Your driver will pickup your shipment(s) as usual.

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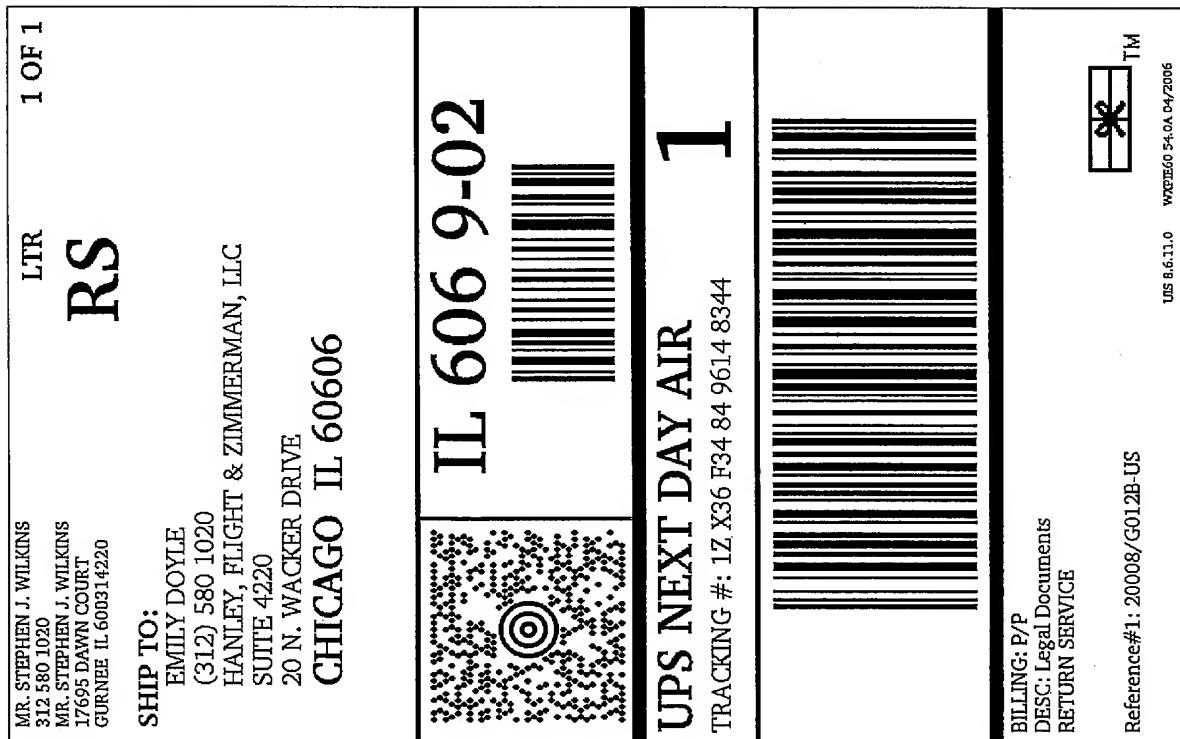


EXHIBIT D**UPS Internet Shipping: View/Print Label**

1. **Print the label(s):** Select the Print button on the print dialog box that appears. Note: If your browser does not support this function select Print from the File menu to print the label.
2. **Fold the printed label at the dotted line.** Place the label in a UPS Shipping Pouch. If you do not have a pouch, affix the folded label using clear plastic shipping tape over the entire label.

3. GETTING YOUR SHIPMENT TO UPS**Customers without a Daily Pickup**

- Schedule a same day or future day Pickup to have a UPS driver pickup all of your Internet Shipping packages.
- Hand the package to any UPS driver in your area.
- Take your package to a location of The UPS Store®, UPS Drop Box, UPS Customer Center or Authorized Shipping Outlet near you. Items sent via UPS Return Services (including Ground Returns) are accepted at any UPS Drop Box.
- To find the location nearest you, please visit the 'Find Locations' Quick link at ups.com.

Customers with a Daily Pickup

- Your driver will pickup your shipment(s) as usual.

FOLD HERE

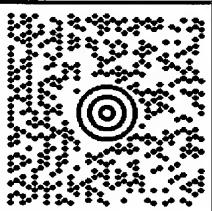
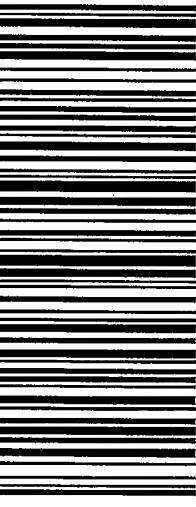
SARAH DOYLE (312) 580 1020 HANLEY, FLIGHT & ZIMMERMAN, LLC 312 580 1020 20 N. WACKER DRIVE CHICAGO IL 60606	LTR SHIP TO: MR. STEPHEN J. WILKINS 312 580 1020 MR. STEPHEN J. WILKINS 17695 DAWN COURT GURNEE IL 60031-4220	1 OF 1
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UPS NEXT DAY AIR SAVER 1P		
TRACKING #: 1Z X36 F34 13 9718 0136		
		
BILLING: P/P		
Reference#: 1: 20008/G012B-US		
TMS 8.6.11.0 04/04/2006		

EXHIBIT E



 Close Window

Tracking Summary

Tracking Numbers

Tracking Number: 1Z X36 F34 13 9718 013 6
Type: Package
Status: Delivered
Delivered on: 09/01/2006
10:33 A.M.
Delivered to: GURNEE, IL, US
Service Type: NEXT DAY AIR SAVER

Tracking results provided by UPS: 06/26/2007 3:59 P.M. EST (USA)

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